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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,283	04/22/2004	Tsutomu Ide	252187US2	7250

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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RESAN, STEVAN A

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/829,283

Applicant(s)

IDE ET AL.

Examiner

Stevan A. Resan

Art Unit

1773

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5,7 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) 3,7,12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,9-11 and 14-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for a disk or powder particles in disk form in claim 1

4. Newly submitted claims 12 and 13 as well as dependent claims 3 and 7 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 1,5,9-11 and 14-20 are directed to an article in class 428 subclass 844 while Claims 3,7,12 and 13 are directed to a method classified in class 427 subclass 128.

The inventions are distinct, each from the other because:

The Inventions are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown:

(1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as slide coating (Note that the limitation of the process in the article claim carries no weight). Note also that applicants have set forth in the specification SUMMARY OF THE INVENTION that any coating method may be used.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims

3,7,12 and 13 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. Claims 1,5,9-11 and 14-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Katsumi et al JP 06-052541 for the reasons of record.

6. Claims 1,5,9-11 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsumi et al as applied to claim 1 above, and further in view of Ozue et al (IEEE Trans.) and/or Kobayashi et al US 5648886.

These references have been added for teaching that it was old in the art at the time of the invention to employ MR heads with VTR systems and that one of ordinary skill in the art would have been motivated to do so by the desire to increase recording density.

7. Applicant's arguments filed 19 September 2005 have been fully considered but they are not persuasive.

Applicants traverse the rejection based upon Katsumi arguing that Katsumi does not teach or suggest a magnetic layer configured to store information to be reproduced by a MR head. However applicants have not defined exactly what physical or chemical features define this configuration. Furthermore the writing or reading of information to or from the media with a particular magnetic head is merely a statement of intended use no matter how many details of the head are included. If applicants' invention requires a MR head , claims should be drawn to an apparatus comprising a medium and head.

Applicants also argue that before optimization can be used the prior art must present some recognition that the variable to be optimized is a results effective one. The examiner agrees that the variable to be optimized must be results effective but disagrees that there is no art recognition that different heads perform differently. Evidence for this resides in the multiplicity of head structures proposed and patented. The examiner, however, in addition, has presented additional evidence showing the recognition that a MR head is more desirable than an inductive head in a VTR system such as used by Katsumi.

Applicants argue that Katsumi does not teach or suggest the lower limit of the average height of protrusion. Applicants argue that there is no motivation to select the lower limit in applicant's claimed range. However "a prior art reference that discloses a range encompassing a somewhat narrower range is sufficient to establish a prima facie case of obviousness" In re Peterson, 315 F3rd 1325, 1330. 65 USPQ2d 1379, 1382-1383 (Fed Cir 2003).

The examiner points out that Katsumi does indeed teach, or renders obvious the limits in the new dependent claims. (See Katsumi [0010], [0012], [0027], [0032]).

The examiner notes that data of examples is presented in the specification. In order to prove unexpected results applicant has the responsibility to explain the content and significance of data (In re D'Ancicco 439 F 2d 1244, 1248, 169 USPQ 303,306 CCPA 1971) and must show that the results are truly unexpected. (In re Merck & Co. 800 F 2d 1091, 1099, 231 USPQ 375, 381, (Fed. Cir. 1981)).

Furthermore, if applicants are relying upon unexpected results when compared with the closest prior art, they have not fulfilled the requirement for side by side testing nor demonstrated that their claims were

commensurate in scope with the evidence presented. The limited comparative data is hardly commensurate with the extensive class of magnetic recording media encompassed by the claims. In re Grasselli 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is 571-272-1513. The examiner can normally be reached on Tues-Thurs from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
STEVAN A. RESAN  
PRIMARY EXAMINER